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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,529	02/24/2005	Markus Scherer	266010US0PCT	7078
22850 7590 01/19/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MULCAHY, PETER D				
ART UNIT		PAPER NUMBER		
1762				
NOTIFICATION DATE		DELIVERY MODE		
01/19/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/525,529

**Applicant(s)**

SCHERER, MARKUS

**Examiner**

Peter D. Mulcahy

**Art Unit**

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-59 is/are pending in the application.
- 4a) Of the above claim(s) 35-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33, 34 and 42-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of water (claim 34) as component "D)" in the reply filed on 11/15/10 is acknowledged. Claims 35-41 stand withdrawn from consideration at this time.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 33, 34 and 42-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 33 is indefinite in that the claimed components A) through D) overlap in scope with one another. This is to say that one ingredient can fall within the scope of more than one of the claimed elements. Specifically, the polyolefin component A) can be a copolymer of butadiene/isoprene as requisite claim 47. The dispersing component B) can also be copolymer of butadiene/isoprene, claim 42. Further, the "carrier medium" is conventionally understood to read on water and solvents which overlap with component D). The claimed components must be limited so as to be distinguishable each from the other.

5. Claim 44 depends from claim 33 and contains the language "said monomer composition". This has no antecedent basis in claim 33.

6. The percentages of claim 54 are outside the scope of claim 33 from which it depends. As such, the dependent claim is not further limiting.
7. Claims 55 and 59 are indefinite. Each claims the mineral oil species. Claim 55 appears to claim the oil as an additional component. Claim 59 claims the oil as a species of carrier medium C). This is indefinite as these clearly overlap and it is unclear just how many components are to be in the dispersion. Clarification is required.
8. The claimed "dispersing component" B) and "carrier medium" C) are further indefinite. Surfactants, emulsifiers and soaps are known as conventional "dispersing medium[s]". Carrier mediums are understood to be solvents and water. Applicant claims a conventional anionic surfactant as a species of "carrier medium". It appears that the functional language is inconsistent with the chemical species. Clarification is required.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
10. Claims 33-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Homma et al. US 4,970,258.
11. The claims are directed to a dispersion comprising "A) at least one dispersed polyolefin, B) at least one dispersing component, C) at least one carrier medium and D) from 0.3 to 15% by weight of at least one compound selected from the group consisting

of water". This is understood to read on an aqueous dispersion comprising a polyolefin A), dispersing component B) and carrier medium C) where the "aqueous" component of the dispersion reads on component D).

12. Homma et al. shows aqueous dispersions comprising dispersed polyolefins see the abstract and column 5 lines 29-45. The dispersing component B) is disclosed as the polymer (ii) at column 6 lines 18+ as well as the surfactants. Surfactants are art recognized as dispersants. These are extensively disclosed at column 8 lines 18+. The solvents and non-ionic surfactants at column 8 lines 47-65 and column 13 lines 25-30.

13. The mineral oil of claim 55 is disclosed at column 8 lines 65-70. This further suggests the lubrication oil "formulation" of claim 57. The "sticking-preventing agent" further suggests the use of the composition as a lubricating formulation.

14. The difference between the claimed invention and the cited art is that the art fails to provide an anticipatory example. The claims are rendered prima facie obvious from this disclosure given that each of the claimed components is shown and suggested to be used in combination.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy whose telephone number is 571-272-1107. The examiner can normally be reached on Mon.-Fri. 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter D. Mulcahy/  
Primary Examiner, Art Unit 1762